

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Anderson et al.
Appl. No. : 09/663,963
Filed : 09/19/00
Title : IMPROVED FERMENTATION PROCESS

Grp./A.U. : 1651
Examiner : K. Srivastava

Docket No. : M6560 OS/OAPT

#17

CERTIFICATION OF FACSIMILE TRANSMISSION

I hereby certify that this paper is being facsimile transmitted to the Assistant Commissioner for Patents on the date shown below.

October 16, 2001
Date

Marlene Caprer
Signature of certifier

Marlene Caprer
Typed or printed name of certifier

Commissioner for Patents
Washington, DC 20231

**PETITION FOR WITHDRAWAL FROM
REQUIREMENT FOR RESTRICTION UNDER 37 CFR 1.144**

Sir:

Applicant hereby petitions the Honorable Commissioner of Patents and Trademarks to review the Examiner's restriction requirement in the above-identified application for patent.

Applicant had received an Examiner's Restriction Requirement on April 18, 2001 in the instant application.

The Examiner has made claims 1-28 subject to restriction requirement. The Examiner has indicated that the invention of Group I, claims 1-12, is said to be drawn to a culture medium composition classified in **Class 435**, subclass 253.6 The invention of Group II, claim 13, is said to be directed to a culture medium composition classified in

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Class 435, subclass 254.2. The invention of Group III, claims 14-28, is said to be directed to a process for making polycarboxylic acids using the culture medium of Groups I and II in combination with *C. tropicalis*, classified in **Class 435**.

The Examiner also contends that the application is directed to numerous patentably distinct species of the claimed invention.

The Examiner contends that the inventions are distinct, each from the other, on the grounds that the combination does not require the particulars of the sub-combination as claimed due to the presence of additional ingredients. Applicant respectfully disagrees with this contention for the following reasons.

With respect to the inventions of Groups I and II, all of the claimed elements of claim 13 (Group II) find antecedent basis in claim 1 (Group I). Claim 13 discloses, with specificity, the preferred elements of the independent claim 1. More particularly, the source of carbon and energy disclosed in claim 1 is disclosed in claim 13 as being, specifically, glucose. The source of inorganic nitrogen disclosed in claim 1 is disclosed in claim 13, specifically, as being ammonium salt. The same holds true for the remaining ingredients. Clearly, the invention of Group II, claim 13, finds antecedent basis in claim 1 since the purpose of claim 13 is to define a preferred embodiment of the invention of claim 1. Based on the Examiner's logic, claims which go on to further limit the scope of preceding claims are all subject to restriction/election.

Applicant also respectfully submits that the fact that the inventions of both Groups I and II are **admittedly** found in the same class, i.e., **435**, clearly supports Applicant's contention that these inventions should not be grouped separately.

Finally, with respect to the invention of Group III, claims 14-28, it, too, is found in the same class, i.e., **435**, as the other claims. Applicant respectfully submits that the Examiner has failed to meet the burden of proof necessary in order to justify grouping claims (1-12)

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in Group I, claim (13) in Group II, and claims (14-28) in Group III. All three Groups are directed to the making of carboxylic acids and as such are classified in a **single** class, namely, **435**, as is admitted by the Examiner in Paper No 6, page 2. Therefore, Applicant respectfully submits that in order to properly consider the invention herein claimed, the subject matter of indicated Groups I-III must be considered together. Thus, restriction of the application to a single group would **clearly** not appreciably shorten the necessary search since **only Class 435** need be searched.

With respect to the Examiner's election of species requirement, Applicant would initially like to note that *MPEP* section 803.02 states that restriction/election of a Markush-group is proper "...where two or more of the members are so unrelated and diverse that a prior art reference anticipating the claim with respect to one of the members would not render the claim obvious under 35 U.S.C. § 103 with respect to the other member(s)." Clearly, the Examiner has failed to show that the members of Applicant's Markush-group are in fact so unrelated and diverse.

Secondly, Applicant respectfully submits that restriction of the claimed invention to a single species is clearly improper since all of the members of the Markush group: (1) share a common utility and (2) share a substantial structural feature disclosed as being essential to that utility. See, *MPEP* 803.02.

Applicant respectfully submits that **NONE OF THE REQUIREMENTS** necessary for establishing a restriction/election requirement pursuant to *MPEP* section 803 have been satisfied by the Examiner and, as a result, said requirement is woefully improper.

The Commissioner is hereby authorized to charge our Deposit Account No. 50-1177 in the amount of \$130.00 for submission of this petition; Order No. 01-0644

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In view of the above, Applicant respectfully requests that the Commissioner withdraw the Examiner's restriction/election requirement for the above-stated reasons.

Respectfully submitted,



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